

**REMARKS**

The claims of the present application are subject to a restriction requirement, and in a telephone conference with the Examiner on August 11, 2004, Group I (claims 1-17) was elected for prosecution in this application. Applicant hereby affirms the election. Applicant expressly reserves the right to file the claim relating to the non-elected invention in a divisional application.

In the Office Action, the Examiner rejected the claims citing a number of references. The claims have been canceled and new claims have been added. The new claims specifically recite, among other things, a rotary die plate made of a solidified resin having magnetic elements therein to make the die plate attractable to a metal cylinder, and that the die is mountable on the cylinder without having to use screws clamps or other mechanical holding devices. The magnetic elements provide that the die plate is easy to mount, and that no gap exists between the die plate and the cylinder. It is believed that the new claims are distinguishable from the prior art of record, including those references which were cited in connection with rejecting the claims. Each of the main references which were specifically relied upon in rejecting the claims is addressed below.

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**Sardella**

The Examiner relied upon Sardella et al. (U.S. Patent No. 4,744,297) in rejecting some of the claims. Of the newly added claims, claims 21 and 25 are independent. Both claims recite, among other things, a rotary die plate made of a solidified resin having magnetic elements therein to make the die plate attractable to a metal cylinder, and that the die is mountable on the cylinder without having to use screws clamps or other mechanical holding devices. Sardella does not disclose or suggest providing as such, and instead discloses a die plate which is held to a cylinder via suction (see, for example, col. 5, lines 40-43, and col. 5, line 47 onward). In fact, Sardella not only discloses suction, but is entirely focused on a suction method (see, for example, the claims, the abstract and the summary of the invention from col. 2, line 42 onward). As such, Applicant respectfully submits that the reference teaches away from what is being specifically claimed in claims 21 and 25. A basic tenet of U.S. patent law is that "an invention that otherwise might be viewed as an obvious modification of the prior art will not be deemed obvious in a patent law sense when one or more prior art references "teach away" from the invention." *Chisum on Patents*, § 5.03[3], at 5-135 (2000). See, for example, Gillette Co. v. S.C. Johnson & Sons, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990) (stating that the closest prior art reference "would likely discourage the art worker from attempting the substitution suggested by the [inventor/patentee]"); American Standard Inc. v. Pfizer Inc., 14 USPQ2d 1673, 1707 (D. Del. 1989) (stating that "[a]lthough each reference used in an obviousness inquiry does not have to be enabling . . . disclosures in the references that

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'teach away' from the claimed invention cannot be disregarded"); Phillips Petroleum Co. v. U.S. Steel Corp., 6 USPQ2d 1065, 1093 (D. Del. 1987), *aff'd*, 9 USPQ2d 1461 (Fed. Cir. 1989) (holding that "the prior art references relied upon must be considered in their entirety . . . Disclosures in the references that diverge from and teach away from the invention cannot be disregarded"); Dow Chemical Co. v. United States, 18 USPQ2d 1657, 1662 (Cl. Ct. 1990) (stating "this is a classic case of 'teaching away' from the invention"). Because Sardella does not disclose or suggest providing what is being specifically claimed in claims 21 and 25, Applicant respectfully submits that these claims and those claims which depend therefrom, are allowable over Sardella.

### **Kang**

The Examiner relied upon Kang (U.S. Patent No. 3,850,059) in rejecting some of the claims. Kang discloses a die for cutting pressure sensitive labels in a manner to wedge the labels and their adhesive apart so that only one label will come loose without pulling another label with it. Kang discloses that the die is made of a thin metal sheet (see col. 3, lines 17-19). In contrast, claims 21 and 25 of the present application specifically claim a rotary die plate made of a solidified resin having magnetic elements therein. Kang does not disclose or suggest providing this structure. Kang mentions at col. 2, lines 64-67 that the "die plate 20 comprises a thin metal plate or sheet which may be easily attached to die support roll 14 by the use of permanent magnets . . . ." However,

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Kang does not give any guidance as to how this would be effected, and certainly does not disclose what is being specifically claimed in claims 21 and 25 (i.e., that the die plate is formed of a solidified resin having magnetic elements therein). Kang discloses that the die plate is metal, and does not mention or suggest using any other type of material.

Although Kang mentions in passing the use of permanent magnets, Kang does not explain how such permanent magnets would be implemented in association with a thin metal die plate. Applicant respectfully submits that Kang does not disclose or suggest what is being specifically claimed in claims 21 and 25, and that Kang is a non-enabling disclosure with regard to an embodiment using magnets. Applicant respectfully submits that attempting to interpret Kang as disclosing or suggesting what is being specifically claimed in claims 21 and 25 would amount to hindsight and would be improper. There are many court decisions which hold that using hindsight is improper. As early as 1891, the United States Supreme Court held that:

Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention. But the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not. It regards a change as evidence of novelty, the acceptance and utility of change as further evidence, even as demonstration . . . Nor does it detract from its merit that it is the result of experiment and not the instant and perfect product of inventive power. A patentee may be baldly empirical, seeing nothing beyond his experiments and the result; yet if he has added a new and valuable article to the world's utilities, he is entitled to the rank and protection

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of an inventor . . . It is certainly not necessary that he understand or be able to state the scientific principles underlying his invention, and it is immaterial whether he can stand a successful examination as to the speculative ideas involved.

Diamond Rubber Co. v. Consolidated Rubber Tile Co., 220 U.S. 428 , 435-36.

As such, Applicant respectfully submits that claims 21 and 25, and those claims which depend therefrom, are allowable over Kang.

Applicant respectfully submits that at least some of the dependent claims further distinguish the claimed invention from that which is disclosed in Kang. For example, claims 23 and 26 specifically claim that the cutting blade has a cutting edge which extends at least 0.125 inches above an outer surface of the rotary die plate. In contrast, as discussed in Kang, the die which is used is a thin metal sheet, and the thin metal sheet has raised cutting edges having "very small dimensions" (see col. 3, lines 24-28). This is because Kang is focused on not cutting through all the layers of the material, as opposed to cutting all the way through the substrate.

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**Fuller**

The Examiner relied upon Fuller (U.S. Patent No. 5,555,786) in rejecting some of the claims. Fuller discloses a flexible foil cutting die which is held to a cylinder via clamps (see col. 5, lines 12-43) and permanent magnets on the cylinder. In contrast, claims 21 and 25 specifically claim that the rotary die plate is formed of a solidified resin having a plurality of magnetic elements therein, and that the rotary cutting die is mountable on the metal cylinder without having to use screws, clamps or other mechanical holding devices. Applicant respectfully submits that this structure is neither disclosed nor suggested by Fuller. Applicant respectfully asserts that claims 21 and 25, and those claims which depend therefrom, are allowable over Fuller.

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**Conclusion**

Claims 21 and 25 specifically claim, among other things, a rotary die plate which is formed of a solidified resin having a plurality of magnetic elements therein, and that the rotary die plate is configured such that it is mountable on a metal cylinder without having to use screws, clamps or other mechanical holding devices. Applicant respectfully submits that none of the cited references, either alone or in combination disclose or suggest providing such structure. Therefore, Applicant respectfully asserts that claims 21 and 25, and those claims which depend therefrom, are allowable. Claim 30 is similar, but is directed to a method. Applicant respectfully submits that claim 30, and claim 31 which depends therefrom, is allowable.

Should the present claims not be deemed adequate to effectively define the patentable subject matter, the Examiner is respectfully urged to call the undersigned attorney of record to discuss the claims in an effort to reach an agreement toward allowance of the present application.

Respectfully submitted,

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